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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,076	09/15/2003	Ross Chun		7099

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Ross Chun  
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Aliso Viejo, CA 92656

EXAMINER

BODDIE, WILLIAM

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/661,076

Applicant(s)

CHUN, ROSS

Examiner

William Boddie

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The specification is lacking a detailed description of the invention as required by 37 CFR 1.71. As such the specification is objected to.
2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use. Please note the Detailed Description of the Invention specifically.

### **Content of Specification**

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

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- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the

field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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There is no mention of any of the characteristics of the stylus material (e.g. flexible, injection-molded plastic, won't scratch the touch screen) anywhere in the specification.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being anticipated by Levine (US 4,954,817) in view of Christenson (US 5,973,243).

**With respect to claim 1**, Levine discloses, a thumb stylus (14 in fig. 1) for use with touch-screen interface PDA's (20-28 in fig. 1), is constructed with a tapered tip (12 in fig. 1) that allows for accurate selection of menus and menu items within the PDA's interface (col. 7, lines 30-49).

Levine does not expressly disclose that the thumb stylus is constructed of a single piece of injection-molded plastic, flexible.

Christenson discloses, a thumb stylus (10 in fig. 1) that is constructed with a single piece of injection-molded plastic, flexible (col. 3, lines 56 – col. 4 line 12).

Christenson and Levine are analogous art because they are both directed to a similar problem solving area, simplified user interfaces using finger-mounted styluses.

At the time of the invention it would have been obvious to one of ordinary skill in the art to construct the thumb stylus of Levine in a manner similar to that disclosed by Christenson.

The motivation for doing so would have been, to eliminate the weakness in the device caused by fatiguing or deforming the material (Christenson, col. 4, lines 17-18).

Therefore it would have been obvious to combine Christenson with Levine for the benefit of eliminating weakness associated with fatigue to obtain the invention as specified in claim 1.

**With respect to claim 2**, Levine and Christenson disclose, the thumb stylus as described in claim 1 (see above).

Levine discloses, placing the stylus on the user's thumb.

Levine does not expressly disclose partially wrapping the stylus around the user's thumb, leaving an open gap that allows for easy application and removal.

Christenson further discloses partially wrapping a stylus around a user's finger, and leaving an open gap (the gap is clearly visible in fig. 3) that allows for easy application and removal.

At the time of the invention it would have been obvious to one of ordinary skill in the art to use the stylus taught by Christenson on Levine's user's thumb. Replacing the thumb stylus of Levine.

The motivation for doing so would have been to affect a more comfortable fit and attractive appearance (Christenson, col. 3, lines 22-24).

Therefore it would have been obvious to combine Christenson with Levine for the benefit of comfort and aesthetics to obtain the invention as specified in claim 2.

**With respect to claim 3**, Christenson and Levine disclose, the thumb stylus of claim 1 (see above).

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Christenson further discloses, using a slightly flexible plastic (col. 4, lines 5-18).

**With respect to claim 5**, Christenson and Levine disclose the thumb stylus of claim 1 (see above).

The further limitations of claim 5, the tapered tip curving away from the user's thumb tip and fingernail are merely design choices. As such they are not given any additional patentably weight.

**With respect to claim 6**, Christenson and Levine disclose, the thumb stylus of claim 1 (see above).

Christenson further discloses that the stylus has a simple elegant design (col. 3, line 24).

Furthermore it is clear from the size of Christenson's stylus that it would easily fit into the user's pocket, briefcase or handbag.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being anticipated by Levine (US 4,954,817) in view of Christenson (US 5,973,243) and further in view of Schneider (US 6,626,598)

8. **With respect to claim 4**, Christenson and Levine disclose, the thumb stylus of claim 1 (see above).

Neither Christenson nor Levine expressly discloses, that the plastic chosen will flex with firm but minimal pressure or that it will not damage the device screen.

Schneider discloses a plastic stylus that will flex with firm but minimal pressure (col. 3, lines 51-59).



Christenson, Levine, and Schneider are all analogous art because they are directed to a similar problem solving area; simplified user interfaces using finger-mounted styluses.

At the time of the invention it would have been obvious to one of ordinary skill in the art to use the plastic taught by Schneider in the construction of the stylus system, taught by Christenson and Levine.

The motivation for doing so would have been, to enable convenient use of the stylus on touch screens (Schneider, col. 3, lines 58-59).

The additional limitation that the plastic used will not damage the device screen is seen as inherent, considering the tip is both tapered (see above) as well as somewhat flexible.

Therefore it would have been obvious to combine Schneider, Christenson and Levine for the benefit of convenient use of the stylus to obtain the invention as specified in claim 4.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Robb (US 6,225,988) discloses a design for a fingertip stylus that has a tapered tip.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Will Boddie whose telephone number is (571) 272-0666. The examiner can normally be reached on Monday through Friday, 7:30 - 4:00 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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